

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
AMAZON.COM SERVICES LLC,
AMAZON WEB SERVICES, INC., and
TWITCH INTERACTIVE, INC.,
Petitioners,

v.

NL GIKEN INC.,
Patent Owner.

Case No. IPR2025-00407
Patent No. 8,677,391

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
REQUEST TO THE DIRECTOR FOR DISCRETIONARY DENIAL OF
INSTITUTION**

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I. INTRODUCTION

Petitioners do not meaningfully dispute the significant investment in the ongoing Delaware litigation. Rather, they hand wave that the multitude of litigation tasks already completed or ongoing (Paper 10 at 4) “includes *many tasks* that typically take place...” (Paper 11 at 8, emphasis added) But Petitioners’ cut-and-paste of its district court Motion to Stay falls flat here. (Ex. 1016)

The “many tasks” of the advancing Delaware litigation constitute a significant investment under agency *Fintiv* precedent that stands un rebutted. Petitioners do little more than advocate for yanking the rug out from under Patent Owner on the basis that “the most burdensome stages of the case—completing discovery, preparing expert reports, filing and responding to pretrial motions, preparing for trial, going through the trial process, and engaging in post-trial motion practice—all lie in the future.” (Ex. 1016 at 8) But the agency’s discretionary analysis is different from the district court’s management of its limited trial resources. What litigation events are “typical” or uncommon given district court settlement rates, or what additional resource intensive work is necessary for the court to *conduct* trial, is of no moment here.

Similarly, Petitioners’ new district court stipulation alleged to eliminate overlap only adds insult to injury. As Patent Owner has explained in its opening brief discussing the first belated stipulation, such belated stipulations do not undo

the months of analysis expended to analyze the final invalidity contentions and associated materials. (Paper 11 at 8). The agency should not sanction such further last-minute rug pulling in the name of “efficiency” months into this preliminary proceeding.

The petition should be denied in view of the advancing litigation and the significant effort expended to date on readying this case for a trial.

II. THE SIGNIFICANT LITIGATION INVESTMENT STANDS UNREBUTTED

The assessment the agency must make here is not to weigh the relative burden of different litigation tasks against one another in terms of judicial economy as in the Motion to Stay (Ex. 1016), but to determine whether the efficiency and integrity of the patent system, accounting for the substantial time and effort invested by the parties and district court in the parallel proceeding, warrant discretionary denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential)

The Director has already identified overlapping tasks completed and ongoing here as constituting significant investment for purposes of discretionary denial. In *Motorola Solutions, Inc., v. Stellar, LLC* the Director explained the parties had already “*served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions.*” IPR2024-01205, Paper 19 at 3 (PTAB Mar. 28,

2025). The majority of tasks in *Motorola Solutions* correspond to the very same tasks that Petitioners attempt to discount here as the “many tasks that typically take place” in a litigation¹. Petitioners fail to acknowledge, let alone address, that the majority of enumerated tasks in *Motorola Solutions* overlap here. Petitioners simply hand wave that *Motorola Solutions* is somehow “inapposite” as the many tasks are not in complete identity. That a district court may consider these many tasks “typical” has no bearing here. This argument fails.

A. The Motion to Stay Admits Timing of IPRs Creates Potential for Inconsistency

Petitioners well understood the issue of the IPR timing when arguing its Motion to Stay, explaining that “[b]ased on the current trial schedule, the FWDs for the ’615 and ’968 IPRs are expected 3 months before trial in this case. If the PTAB institutes the related ’592 IPR, that FWD would also issue before trial . . . If the PTAB institutes the final two IPRs (the ’236 and ’391 patents), those FWDs would likewise issue very close to trial in this case. In other words, this litigation *and the IPR proceedings will proceed in parallel, and at the risk of inconsistent decisions . . .*” (Ex. 1016 at 3, emphasis added). Conversely, in its opposition here, Petitioners speculate the PTAB might institute early in this case and,

¹ Claim Construction will be ongoing at the time of institution (Opening brief set for June 25, 2025)

therefore, discretionarily denial would not be warranted. (Ex. 1016 at 3).

Petitioners are talking out of both sides of their mouth. The significant investment in the Delaware litigation supports discretionary denial

III. MULTIPLE BELATED STIPULATIONS CANNOT BE SANCTIONED

As Patent Owner pointed out in its opening brief with respect to the first belated stipulation (Sotera Stipulation of March 7th), belated stipulations where the PO has been assessing prior art for months serve no purpose but to undermine the integrity of the system. (Paper 10 at 8). In response, Petitioners have brazenly offered a *second* belated stipulation that goes further than the first. (Paper 11 at pgs. 1-2) While removing art from the plate of the district court may very well be embraced on the district court side in assessing its resources, it should not be as well received here months into the process and after the POPR has been filed. Pulling the rug out from under the Patent Owner after it has expended months of time and effort analyzing these positions only amplifies the ongoing and pervasive gamesmanship at work here.

The belated and serial nature of these stipulations cannot undo the wasted overlap expended before their last-minutes existence. This overlap supports discretionary denial.

The petition should be denied.

Respectfully submitted,

Date: May 6, 2025

/Scott A. McKeown/

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on May 6, 2025, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Petitioner, upon the following:

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